Applicant : Jonathan D. Herbach, et al.
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Attorney's Docket No.: 07844-0623001 / P568

REMARKS

Claims 1-8, 23-29, and 35-41 are pending, with claims 1, 3, and 23 being independent.

Claims 3 and 23 have been amended to correct informalities. No new matter has been added.

Reconsideration and allowance of the above-referenced application are respectfully requested.

Claims 1, 3, 4, 6, 7, 23, 25, 28, 36, 37, 39, and 40 stand rejected under 35 U.S.C. § 103(a)

as allegedly being unpatentable over U.S. Pub. No. 2005/0132083 to Raciborski et al.

("Raciborski") in view of U.S. Pub. No. 2003/0028899 to MacInnis et al. ("MacInnis"). Claims

5, 26, and 38 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over

Raciborski in view of MacInnis and in further view of U.S. Pat. No. 5,586,260 to Hu. Claims 8,

27, 38, and 41 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over

Raciborski in view of U.S. Pat. No. 6,006,034 to Heath et al. ("Heath") and in further view of

Hu. Claim 29 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over

Raciborski in view of MacInnis and in further view of U.S. Pat. No. 7,233,981 to Tenereillo et al.

("Tenereillo"). Claims 2, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as allegedly being

unpatentable over Raciborski in view of MacInnis and in further view of U.S. Pub. No.

2003/0135650 to Kano et al. ("Kano"). These contentions are respectfully traversed.

Independent claim 1 recites, "receiving, at a server, a request from a client to take an

action with respect to an electronic document; retrieving a document identifier from the request;

determining whether user authentication is needed based on the document identifier and the

action; subsequent to retrieving the document identifier, sending information specifying an

acceptable authentication procedure; receiving an authentication procedure update request from

the client in response to client processing of the information specifying an acceptable

authentication procedure; <u>obtaining</u>, at the server and <u>in response to the authentication procedure</u>

<u>update request, a software program comprising instructions operable to cause one or more data</u>

<u>processing apparatus to perform operations effecting the authentication procedure</u>; and <u>sending</u>

<u>the software program to the client for use in identifying a current user</u> and controlling the action

with respect to the electronic document based on the current user and document-permissions

information associated with the electronic document."[1] The cited art fails to teach or suggest this

claimed subject matter.

With respect to the operations of determining, obtaining and sending the software

program to the client for use in identifying a current user, as recited in claim 1, the Office cites to

paragraphs [0020], [0032], [0033], [0035], and [0036] of Raciborski as allegedly teaching this

subject matter.[2] However, the authentication referred to here in Raciborski relates to

authentication of the program, not a user, as recited in claim 1.[3] Raciborski explicitly states that:

> Authentication information 312 embedded in the download manager program
> 300-1 can be used by the download manager software 304 to authenticate the
> customized XML 308 and download manager software 304. Any tampering or
> modification could be found by the download manager in this manner. The
> authentication information 312 could be a CRC, signature or hash of customized
> XML 308 and download manager software 304. In another embodiment, the
> authentication information is only generated over the customized XML 308.[4]

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[1] Emphasis added.
[2] *See* 4-30-2009 Office Action at pages 3-5.
[3] *See e.g.,* Raciborski at ¶ [0020].
[4] *See* Raciborski at ¶ [0035].

Thus, it is clear that Raciborski is describing authentication of software and associated XML

data, not authentication of a user, as stated in claim 1.

Moreover, although Raciborski does state that the customized XML can store a password,

and the download manager program "may check the password", Raciborski does not describe

that the download manager program actually includes instructions operable to cause one or more

data processing apparatus to perform operations effecting an authentication procedure for use in

identifying a current user.[5] Thus, Raciborski does not describe sending a user authentication

program as claimed. Since MacInnis fails to cure this deficiency of Raciborski, the rejection of

claim 1 should be withdrawn for at least this reason.

In addition, claim 1 recites, "…sending information specifying an <u>acceptable</u>

<u>authentication procedure</u>; receiving an <u>authentication procedure</u> update request <u>from the client</u> in

response to client processing of the information specifying an acceptable authentication

procedure …"[6] The Office asserts that MacInnis teaches this subject matter in paragraph

[0012].[7] However, it should be noted that the software being updated in MacInnis does not

include an authentication procedure. In addition, the Office admits that MacInnis does not teach

a request for descriptors being received from the client, but goes on to suggest that this would be

obvious in view paragraph [0007] in MacInnis, which describes downloading schemes involving

client-server paradigms.[8] However, paragraph [0007] in MacInnis is in the background section

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[5] *See* Raciborski at ¶s [0041] and [0043].
[6] Emphasis added.
[7] *See* 4-30-2009 Office Action at pages 3-4.
[8] *See* 4-30-2009 Office Action at pages 3-4.

and is describing prior art that MacInnis does not in fact use. Rather, the explicit objective in

MacInnis is to not have the client need to send a request:

> The present invention solves the aforementioned problems by providing a system
> and method for selectively downloading software and data modules to terminals
> in a network without requiring communication between the terminal and the
> downloading source.[9]

Thus, MacInnis actually teaches away from the combination proposed by the Office, and the

proposed combination cannot be made to render the claimed subject matter unpatentable.

For all of the above reasons, independent claim 1 should be in condition for allowance.

Neither Hu, Heath, Tenereillo nor Kano cure the noted deficiencies of Raciborski and MacInnis.

Thus, dependent claims 2 and 4-8 should be allowable based on the above arguments and the

additional recitations they contain.

Independent claim 3 recites, "receiving, at a server, a request from a client to take an

action with respect to an electronic document; obtaining, at the server and in response to the

request, a software program comprising instructions operable to cause one or more data

processing apparatus to perform operations effecting the authentication procedure; sending the

software program to the client for use in identifying a current user and controlling the action with

respect to the electronic document based on the current user and document-permissions

information associated with the electronic document; receiving an updated authentication

procedure; receiving a subsequent request from the client to take the action with respect to the

electronic document; obtaining, at the server and in response to the subsequent request, a new

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[9] *See* MacInnis at ¶ [0011].

software program comprising instructions operable to cause one or more data processing

apparatus to perform operations effecting the updated authentication procedure; and sending the

new software program to the client for use in identifying the current user and controlling the

action with respect to the electronic document based on the current user and the document-

permissions information associated with the electronic document."[10] Thus, independent claim 3

should be in condition for allowance for at least reasons similar to those addressed above with

respect to claim 1.

Independent claim 23 recites, "a client that sends an authentication procedure update

request to a server in response to client processing of information received from the server,

wherein the information received from the server specifies one or more acceptable authentication

procedures; the server that receives the authentication procedure update request, and in response

to the client, the server obtains and sends a software program comprising instructions operable to

cause one or more data processing apparatus to perform operations effecting an authentication

procedure; and wherein the client uses the software program to identify the current user and

control an action with respect to an electronic document based on the current user and document-

permissions information associated with the electronic document, and wherein the action

comprises an action taken with respect to the electronic document subsequent to opening the

electronic document at the client."[11] Thus, independent claim 23 should be in condition for

allowance for at least reasons similar to those addressed above with respect to claim 1.

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[10] Emphasis added.
[11] Emphasis added.

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Moreover, dependent claims 24-29 and 35-41 should be allowable based on the above arguments

and the additional recitations they contain.
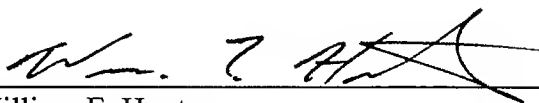
CONCLUSION

It is believed that all of the pending claims have been addressed. However, the absence

of a reply to a specific rejection, issue or comment does not signify agreement with or

concession of that rejection, issue or comment. In addition, because the arguments made above

may not be exhaustive, there may be reasons for patentability of any or all pending claims (or

other claims) that have not been expressed. Finally, nothing in this paper should be construed as

an intent to concede any issue with regard to any claim, except as specifically stated in this

paper, and the amendment of any claim does not necessarily signify concession of

unpatentability of the claim prior to its amendment.

A formal notice of allowance is respectfully requested. Absent this, a telephone

interview with the Examiner and the Examiner's supervisor is respectfully requested.

Please apply any necessary charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: _July 17, 2009_   _____

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